

### REMARKS

Claims 1–28 are pending in the present application. Claims 2-5, 7, 9, and 15 are canceled, while Claims 1, 12, 13, 14, 18, and 22 have been amended, leaving Claims 1, 6, 8, 11–14, and 16–28 for consideration upon entry of the Amendment.

#### Amended Claims

Claim 1 has been amended to better define the invention by incorporating the limitations of Claims 2, 3, 4, and 5 respectively. Additional support for use of Pd and P in claim 1 is found in the Specification, e.g., p. 32, lines 1-3 (Ex. 5; see also Exs. 10, 20, 23, 24, 26-32, and 34-38).

Claims 12 and 13 have been amended to provide for the proper antecedent basis from Claim 1. This amendment was not made for reasons of patentability.

Claims 14, 18, and 22 have each been amended to correct inadvertent typographical errors.

No new matter has been introduced by these amendments. Reconsideration and allowance of the claims is respectfully requested based upon the above amendments and the following remarks.

#### Claim Rejections under 35 U.S.C. §102

Claim 1–19 is rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,455,650 (“Lipian”). Applicants respectfully traverse this rejection.

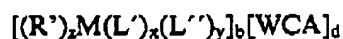
In making the rejection, the Examiner has stated that “Lipian (Col. 112-3, claims 1 and 2; Col. 115-116, claims 16 and 17; Col. 40, line 19–59 disclose a method for preparing a cycloolefin polymer that is substantially identical to Applicants' claims

1-19)". See Office Action dated 09-26-2005, page 2.

To anticipate a claim under 35 U.S.C. §102, a reference must disclose each and every element of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

The invention of the instant claims is directed to polymeric yields of greater than 50% when a monomer solution comprising a norbornene-based compound containing a polar functional group is converted in the presence of a precatalyst containing a Group 10 transition metal having a ligand containing oxygen ions bonded to the metal. See Claim 1, above.

Lipian in contrast discloses a method for the addition polymerization of cycloolefins using a cationic Group 10 metal complex and a weakly coordinating anion of the formula:



wherein  $[(R')_z M(L')_x (L'')_y]$  is a cation complex is a cation complex where M represents a Group 10 transition metal; R' represents an anionic hydrocarbyl containing ligand; L' represents a Group 15 neutral electron donor ligand; L'' represents a labile neutral electron donor ligand; x is 1 or 2; and y is 0, 1, 2, or 3; and z is 0 or 1, wherein the sum of x, y, and z is 4; and [WCA] represents a weakly coordinating counter anion complex; and b and d are numbers representing the number of times the cation complex and weakly coordinating counter anion complex are taken to balance the electronic charge on the overall catalyst complex. See Col. 112, line 58 to col. 113, line 9.

Lipian does not teach or suggest a precatalyst containing a polar ligand and a norbornene based monomer containing a polar functional group that are used to produce

yields of over 50%. In all of its examples, where Lipian teaches a precatalyst containing a polar ligand such as palladium (II) trifluoroacetate and a norbornene-based monomer containing polar functional groups, there is no indication that the yield is greater than 50%.

In addition, Lipian teaches that the amount of solvent used is 0 to 20 percent based upon the weight of monomers used in the reaction mixture. Col. 41, lines 30–35. The claimed invention in contrast is directed to a solvent amount of 50 to 800% by weight based on total monomer weight. See Claim 1. Thus once again Lipian does not teach all elements of the claimed invention. For these reasons at least, Lipian does not teach all elements of the claimed invention and cannot anticipate the present invention. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §102 and an allowance of the claims.

Claim Rejections Under 35 U.S.C. § 102/103

Claims 20–24 have been rejected under 35 U.S.C. 102(b) as allegedly being anticipated by, or in the alternative under 35 U.S.C. § 103 (a) as obvious over Lipian. See Office Action dated 09-26-2005, page 3.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165

U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claims 20–24 depend from Claim 1. As noted above, Lipian does not teach all elements of the claimed invention. More specifically, Lipian does not teach polymeric yields of greater than 50% when a monomer solution comprising a norbornene-based compound containing a polar functional group is converted in the presence of a precatalyst containing a Group 10 transition metal having a ligand containing oxygen ions bonded to the metal. In addition as noted above, Lipian does not teach an amount of solvent of between 50 to 800% by weight based upon the weight of the monomer.

Additionally, there is no motivation for one of ordinary skill in the art to modify Lipian in order to arrive at the claimed invention. Since Lipian does not teach all elements of the claimed invention, one of ordinary skill in the art would not find any motivation to modify its teachings to arrive at the claimed combination.

Even if the Examiner were to maintain that there is motivation to modify Lipian, which there is not, the claimed invention produces unexpected results that are not disclosed by Lipian. The Examples in the present application clearly demonstrate that when a norbornene based monomer containing a polar functional group is reacted in the presence of a precatalyst containing a polar ligand, yields of over 50% are achieved. This is not disclosed or suggested by Lipian. Since Lipian does not teach all elements of the claimed invention and since there is no motivation to modify Lipian to arrive at the claimed invention, Applicants believe that the Examiner has not made a *prima facie* case of obviousness over Lipian.

Applicants therefore respectfully request a withdrawal of the obviousness

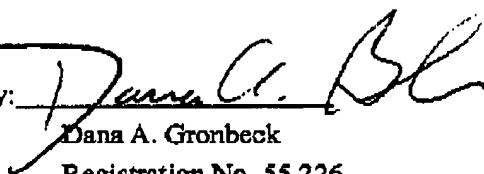
rejection and an allowance of the claims over Lipian.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the objection(s) and rejection(s) and allowance of the case are respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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